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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,999	08/20/2001	Frank-Rainer Bohm	FA-1022	8379

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E I du Pont de Nemours & Company
Legal Patents
Wilmington, DE 19898

EXAMINER
BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
1711	9

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/913,999	Applicant(s) BOHM ET AL.	
	Examiner Melanie D. Bissett	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13,15-19,25 and 26* is/are rejected.

7)☒ Claim(s) *14 and 20-24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. The rejections based on 35 USC 102 have been maintained. Additionally, claim 19, originally objected to as being dependent on a rejected claim, has been included in the rejection using Vassiliou. This change is based on the applicant's amendment to claim 19.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 13, 15-18, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Majumdar et al.

4. From a prior Office action:

> 3. Majumdar discloses a photographic element comprising an antistatic coating layer on a substrate, where the antistatic layer comprises a colloidal silica, a polymeric binder, and an electrically conductive element (abstract). Since the photographic element contains an electrically conductive element, it is the examiner's position that the photographic element is an electrical conductor. The preferred colloidal silica is Ludox AM, a silica modified to contain hydroxyl groups. The silica is a silica-oxygen network in the form of 5-25 nm-particles (col. 5 lines 36-43). The reference teaches a wide range for weight ratios of silica to binder, where additives can also be included (col. 6 lines 32-53). From the discussion in the reference, one of ordinary skill in the art would clearly envision the applicant's claimed weight ratios of the components. Furthermore, from the discussion of surface modification of the silica particles, it is the examiner's position that one of ordinary skill in the art would clearly envision the hydroxyl groups being present in the applicant's broad range of "up to 98 wt.%".
>
> 4. Claims 15-16 limit R_3 and R_4, respectively, without limiting the reactive particles to contain additional radicals R_3 and R_4. Since the silica particles of the reference do not seem to have additional functionality, R_3 and R_4 would not be present, and the further limitations of each additional radical provide no patentable weight over the prior art. In other words, the reference anticipates the claims since the radicals specified are not present.

5. Claims 13, 15-19, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Vassiliou as evidenced by Majumdar et al.

6. From a prior Office action:

> 6. Vassiliou discloses a coating composition comprising a colloidal silica, a fluorocarbon polymer, and a number of additives (col. 1 lines 59-63). The reference prefers the use of Ludox AM (col. 2 lines 30-47), noted by Majumdar as a silica modified to contain hydroxyl groups (col. 5 lines 36-43). Preferred particle sizes range from 7 to 25 millimicrons. Composition A shows ~31 wt.% colloidal silica, ~46 wt.% of polymer binder dispersion, and ~23 wt.% of additives or solvents. From the discussion of surface modification of Ludox AM silica particles in Majumdar et al., it is the examiner's position that one of ordinary skill in the art would clearly envision the hydroxyl groups being present in the applicant's broad range of "up to 98 wt.%". The coatings of Vassiliou's invention are intended for metal substrates, thus providing coating compositions for electrically conductive substrates.
>
> 7. Claims 15-16 limit R_3 and R_4, respectively, without limiting the reactive particles to contain additional radicals R_3 and R_4. Since the silica particles of the reference do not seem to have additional functionality, R_3 and R_4 would not be present, and the further limitations of each additional radical provide no patentable weight over the prior art. In other words, the reference anticipates the claims since the radicals specified are not present.

7. Additionally, Vassiliou teaches the addition of a silicone resin as an anti-mudcracking agent, thus anticipating the applicant's claim 19 (col. 3 lines 58-61; examples).

Allowable Subject Matter

8. Claims 14 and 20-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

10. The closest prior art, Vassiliou, discloses a coating composition comprising a colloidal silica, a fluorocarbon polymer, and a number of additives. The coatings are air-dried and baked; however, the reference does not mention the curing of the fluorocarbon composition at an elevated temperature, nor does the reference mention the use of crosslinking agents. Furthermore, the reference does not suggest the applicant's R_1 radicals of claim 14. It is the examiner's position that the applicant's claimed process including thermal curing steps would be novel and unobvious over the prior art. It is also the examiner's position that the applicant's claimed coating compositions having specific reactive particle according to claim 14 would be novel and unobvious over the prior art.

Response to Arguments

11. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., insulative nature of the coating) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. The compositions of the claims do not exclude electrically conductive components and do not limit the coating composition to an insulative coating. The fact that the coatings of Majumdar contain components not claimed by the applicant does not render the claims novel. The Majumdar reference is enabling to teach an antistatic

backing for photographic paper, where the components of the coating, as set forth above, anticipate some of the applicant's coating claims.

13. Regarding the applicant's arguments that the coating composition is conductive but not the photographic paper, it is noted that the claims do not exclude electrically conductive coatings. It is the examiner's position that, because the coatings of Majumdar contain electrically conductive agents, the coating is "for electric conductors", where the article, as a whole, conducts electricity. It is further noted that the term "for electric conductors" in the claim is an intended use of the coating composition. It is the examiner's position that any coating comprising the applicant's claimed coating components, where the coating is capable of being used in an electrical conductor, would anticipate the claims. The intended use of the coating bears little patentable weight on the coating composition.

14. In response to the applicant's arguments that the colloidal silica of Vassiliou's invention differ from the components of the applicant's invention because the components of the applicant's invention form an inorganic-organic-oxygen network, it is noted that such a network is not claimed. Also, the claims do not require the binder polymers to have functional groups capable of reacting with colloidal silica. The claims only limit the element-oxygen particle to be reactive. Vassiliou's colloidal silica particles anticipate this limitation, since the hydroxyl groups on the silica are inherently reactive. The chemical bond between the binder and reactive particle upon which the applicant relies is not recited in the rejected claims. Furthermore the high partial discharge resistance property relied upon by the applicant is not recited in the rejected claims. It

is the examiner's position, for these reasons, that the cited references anticipate the claims in the broadest interpretation of the claims *as written*.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (703) 308-6539. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

mdb
April 25, 2003

James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700